



APC/ CW  
3727

10/033,634

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	GRENIER ET AL.	Examiner:	S. CASTELLANO
Serial No.:	09/824,937	Group Art Unit:	3727
Filed:	JUNE 15, 2005	Docket No.:	13345.36US01
Title:	DECORATIVE CONTAINER		

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 15, 2005.

By: Kate DeVries Smith  
Name: Kate DeVries Smith

**APPELLANT'S REPLY TO EXAMINER'S ANSWER**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**23552**

PATENT TRADEMARK OFFICE

Sir:

This Reply is presented in support of the Appeal filed October 14, 2004, from the final rejection of the above-identified application, as set forth in the Office Action mailed April, 14, 2004. This Reply is in response to the Examiner's Answer mailed April 15, 2005.

Applicant is not requesting an oral hearing.

This Reply addresses arguments and comments about the above-captioned application that were raised in the Examiner's Answer. Briefly summarizing, two rejections of the pending claims are up on appeal and the two rejections involve the following four references:

- Kimura, U.S. Patent No. 5,553,735, a drinking vessel with display function;
- Gallegos, U.S. Patent No. 5,275,277, a novelty drinking glass; and
- Barnes, U.S. Patent No. 5,674,546, an omelet microwave cooking container;
- Tupper, U.S. Patent No. 2,802,590, a waste can cover.

The two obviousness rejections involve the following combinations of the references:

1. Kimura in view of Barnes and further in view of Tupper; and
2. Gallegos in view of Barnes and further in view of Tupper.

The Examiner is correct in his statement that the two rejections can be analyzed simultaneously, because they are both based on a primary reference (Kimura or Gallegos) that shows a drinking vessel with many of the same features.

This reply focuses on why the Examiner is incorrect in his analysis of motivation to combine the references, as determined by 35 U.S.C. § 103, especially the motivation to modify the "sealing foil" of the upper container of the disposable omelet cooking container of Barnes to have a "groove and flange" as taught by the waste can cover with a region for holding deodorizers in Tupper.

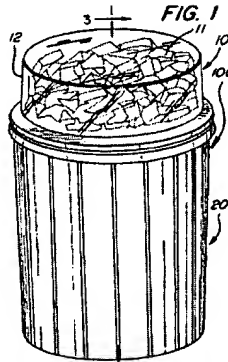
Applicant also asserts that there is no motivation to provide a drinking vessel from Kimura or Gallegos with a lid with a cavity from Barnes, and that the references would not be combined by one of skill in the art because they are nonanalogous. These other issues are discussed more fully in the Appeal Brief and will not be further addressed in this Reply Brief.

**A. The Examiner has made the mistake of using hindsight to determine motivation under 35 U.S.C. § 103**

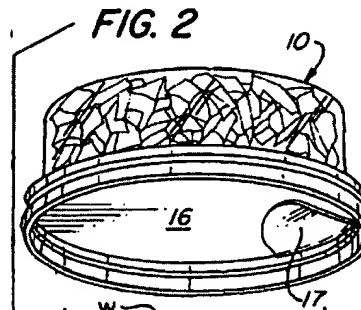
The Examiner's reasons for modifying the Barnes upper container in view of Tupper, as stated in the final office action at page 4, are "to change the contents and store a refreshed supply of items in the hollow lid cavity." The Examiner's Answer states the same motivation.

The specific modification to the Barnes upper container 10 that the Examiner is proposing is that the sealing foil 16 having tab 17, shown in Illustration B below, which is described as being "metal foil, polymeric foil or a composite of metal foil and polymer" (Barnes, Col. 5, lines 56-60) would be modified so that it could be replaced on the upper container 10 after it had been peeled off.

**Illustration A: FIG. 1 of Barnes**

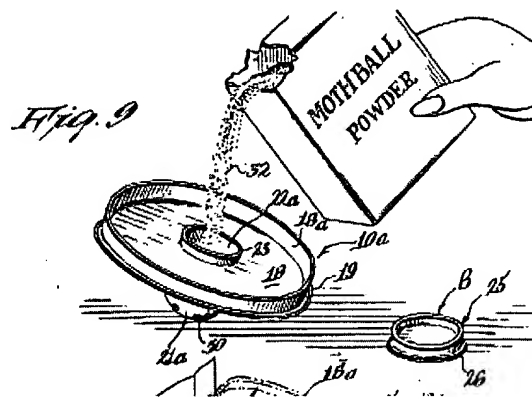


**Illustration B: Part of FIG. 2 of Barnes**



Specifically, the sealing foil 17 of Barnes would allegedly be modified according to the teachings of Tupper, which is a waste can with a cover that has a region for receiving deodorant tablets or powder. A plate closes the region for deodorant. The plate includes a groove 25 that engages a flange 23 of the waste can cover. *See, e.g., Tupper, Column 4, lines 35-38.* According to the Examiner's proposed modification, the sealing foil 17 and upper container 10 of Barnes would be provided with a groove and flange as described in Tupper.

**Illustration C: FIG. 9 of Tupper**



A claimed invention must be considered as a whole. One must avoid hindsight and (a) step back in time just before the invention was made (b) into the mind of a hypothetical "Person of Ordinary Skill in the Art" who does not know the invention. *In re Dembiczak*, 175 F.3d, 994, 999; 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999). The phrase, "at the time the invention was

made" is supposed to guard against applying hindsight. Id. To avoid the "powerful attraction" of hindsight, requires a rigorous application of showing the teaching or motivation to combine prior art references. Id.

In Dembiczak, the appellants' claims in their patent application were directed toward a large trash bag made of orange plastic that when filled with trash or leaves would resemble a Halloween-style pumpkin or jack-o'-lantern. The claims specified "facial indicia" on the outer surface of the bag. Id. at 995; 1615. Among the references cited by the examiner in an obviousness rejection under 35 U.S.C. §103 were "conventional" plastic lawn bags and a children's book describing a method of making a "paper bag pumpkin" by stuffing a bag with newspapers, painting it orange, and then painting on facial features with black paint.

The Federal Circuit emphasized that obviousness rejections require a clear and particular showing of the teaching or motivation to combine prior art references, which most often comes from the teachings of the pertinent references, and must be supported by actual evidence. Id. at 999; 1618. The Federal Circuit also stated that close adherence to the methodology for analyzing 103 rejections is "especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'" Id. at 999; 1617, quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540; 220 U.S.P.Q. 303 (Fed. Cir. 1983).

The Examiner's alleged motivation for modifying the "sealing foil" of Barnes to be replaceable is really a hindsight-based restatement of what the Applicant's invention accomplishes. Lori Greiner, the Applicant, developed a decorative container system that allows a user to change the decorative design based on time of year or for specific events such as Christmas or Independence Day, and display decorative objects in a lid cavity as well as in sidewall cavities. Just as in Dembiczak, where a simple invention improved the appearance of a trash bag, the Applicant has resolved a problem that may seem very simple in hindsight, that of creating a decorative container that is decorative on all sides, including the top, and is therefore more visually appealing, where the decorative theme may be easily changed.

**C. One of skill in the art would not be motivated to combine the references.**

The alleged motivation to combine the Barnes and Tupper references is also not convincing because of the different purposes of the structures taught in those patents. Barnes describes an omelet-cooking container for one-time use that makes omelets a more convenient food to cook in the microwave. The omelet cooking container of Barnes on the other hand is designed for one-time use and is made of disposable materials like paperboard, paperboard-polymer laminates, foamed plastic, or polystyrene that are not suited for washing and reuse. (*See Barnes, Col. 6, lines 11-24.*) The omelet cooking container of Barnes is designed for one-time use and is made of disposable materials like paperboard, paperboard-polymer laminates, foamed plastic, or polystyrene that are not suited for washing and reuse. (*See Barnes, Col. 6, lines 11-24.*) Tupper describes a waste can with a means of deodorizing the odors present in the waste can, the type of item that is often used for many years before it is discarded. Tupper's deodorized waste can and Barnes' one-time use omelet cooker are so different and serve such different purposes that one of ordinary skill in the art would not seek to combine these references.

The Examiner notes that "disposable" items can in fact often be reused, while more durable items can in fact be discarded after one use. While this is true, if a product is likely to be thrown away after one use, this is a factor that one of skill in the art will consider when designing it, and will therefore be less likely to borrow product features that allow for reuseability from items intended for long-term use. For these additional reasons, one of skill in the art would not be motivated to modify the peelable sealing foil 16 of Barnes by adding a groove and flange arrangement borrowed from Tupper.

**D. The Claims are not Obvious over Kimura or Gallegos in view of Barnes**

At page 7 of the Examiner's answer, the Examiner suggests that the claims may be obvious in view of Kimura or Gallegos in view of Barnes, without making any modifications based on Tupper, because the foil 17 of Barnes could be replaced on the upper container 10 even

after it has been peeled from it's releasable adhesive. Applicant respectfully submits that Barnes does not teach or suggest the replaceability of the foil 17, and no such teaching is cited in the Examiner's answer. Nor is the replaceability of the foil 17 inherent in the structure disclosed in Barnes.


**E. Summary**

The Examiner has provided insufficient reasoning for a 35 U.S.C. 103 rejection, and it is earnestly requested that the Examiner's rejections be reversed, and that all of the pending claims be allowed.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(612) 332-5300

Date: June 15, 2005

  
\_\_\_\_\_  
Katherine M. DeVries Smith  
Reg. No. 42,157

## **APPENDIX 1**

### **CASES CITED IN THE REPLY BRIEF**

In re Dembiczak, 175 F.3d, 994; 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999)